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Docket No.: KCC-16,986

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Title: PRODUCT SEAL OF DISSIMILAR
MATERIALS

NEW APPEAL BRIEF

Mail Stop APPEAL BRIEF-PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

I hereby certify that this correspondence (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

08 December 2004.

08 Dec 04
Date

Eric Krischke
Signature

KCC-2102

E/I

Applicants herewith file a New Appeal Brief in the above-identified U.S. Patent Application, pursuant to the Notice of Non-Compliance from the Office dated 24 November 2004.

I. REAL PARTY IN INTEREST

The real party in interest is Kimberly-Clark Worldwide, Inc., the assignee of the present application (as recorded at reel 012748, frame 0566).

II. RELATED APPEALS AND INTERFERENCES

Applicants are not aware of any related appeals or interferences with regard to the present application.

III. STATUS OF CLAIMS

The present Appeal is directed to Claims 1-12 and 40-43, as presented in Appendix A, which were finally rejected in the Office Action mailed 19 March 2004. Claims 13-39 were withdrawn from consideration.

IV. STATUS OF AMENDMENTS

A Response to Final Rejection was filed on 19 May 2004, in response to the Final Office Action mailed 19 March 2004. No amendment was made to the pending claims in the Response to Final Rejection. An Advisory Action mailed 21 June 2004 indicated that the response was entered for purposes of Appeal.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The present invention is directed to an absorbent article comprising a front waist region 22, a back waist region 24, and a crotch region 26 extending between the waist regions 22, 24, as shown in Figs. 2-6. See Applicants' specification at page 14, lines 1-6. A first ear panel 106 is formed of a first material extending from a first edge portion of the front waist region 22. A second ear panel 107 is formed of a second material different from the first material extending from a first edge portion of the back waist region 24, as shown for example in Fig. 6. The second material has a basis weight greater than a basis weight of the first material. At least one manually tearable passive bond 70 connects the first ear panel 106 and the second ear panel 107 together. See Applicants' specification at page 41, line 1 through page 42, line 11; and Fig. 6, for example.

Thus, the present invention is directed to an absorbent article having side seams which include a front ear passively bonded to a back ear. The front ear is made of a first material having a first basis weight and the back ear is made of a second material different from the first material and having a second basis weight greater than the first basis weight. Bonding two dissimilar materials at the side seam, for example a front ear and a back ear, using passive bonds allows the front ear to tear more easily than the back ear. The pant-like, refastenable disposable absorbent article of the present invention includes side seams which include a front ear passively

bonded to a back ear, wherein the front ear is releasable from the back ear without tearing or damaging the back ear more than the front ear and, preferably, not damaging the back ear or negatively affecting its tensile strength. See Applicants' specification at page 7, line 6 through page 8, line 2; page 43, line 12 through page 44, line 6; and Example 2, pages 45-51.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection to be reviewed on appeal are:

1. Claims 1, 8 and 40-43 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,622,589 ("Johnson et al.");
2. Claims 2-7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson et al.; and
3. Claims 9-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson et al. in view of U.S. Patent 6,036,805 ("McNichols"), and thus also U.S. Patent 5,226,992 ("Morman").

VII. ARGUMENT

Claims 1, 8 and 40-43 Are Not Anticipated By Johnson et al.

In the final Office Action mailed 19 March 2004, the Examiner rejected Claims 1, 8 and 40-43 under 35 U.S.C. § 102(b) as being anticipated by Johnson et al.

At paragraph 6 of the Office Action, the Examiner writes:

With regard to all the claims, see Figures 3-3A, then see Figures 5-7, then see Figure 4. Also see Figures 1-2 and 8, col. 3, lines 56-60, col. 6, line 16-col. 7, line 12, col. 7, line 38-col. 8, line 44 and col. 9, lines 6-42, i.e. the front waist region is 56, the back waist region is 54, the crotch region is 57, the first ear panel is 202 or 200, the second ear panel is 200 or 202, respectively, and the bond is 205, 300, see again Figures 4 and 5 (Note a tearable 205 could also be used as 205 in the embodiment of Figure 4). Panels 200 and 202 are different materials, see again, for example the paragraph bridging cols. 7-8.

The Examiner continues:

With regard to claims 1 and 8, the claim requires the second material having a basis weight greater than the basis weight of the first material. See again the paragraph bridging cols. 7 and 8 and col. 7, lines 6-12 of Johnson (At the very least, one of 200 or 202 could be a single layer of material and the other of 200 or 202 can be a layer of that material and another layer, i.e. a laminate or “different material” which has a basis weight greater than the one member or since the panels are shown as the same thickness and size but they can be of different materials the members can have different basis weights. It is again noted that panel 200 can be in the front or the rear and 202 in the rear or the front).

With regard to the functions, properties and capabilities of the “passive bond” as defined in the independent claims, see claim language interpretation section supra, the Johnson device includes all the structure of the claims. Therefore there is sufficient factual basis for one to conclude that the functions, properties and capabilities of the claimed structure are inherent in the same structure of Johnson. See MPEP 2112.01. Also note Figure 8 which shows tearing of the bond of Johnson increases the size of the waist opening.

Finally, the Examiner writes:

With regard to the last subsections of claims 41-43, see Figures, e.g., Figure 4 and 205 in Figures 5-7, i.e. panel 200 or 202 remain in the same form, i.e. is not damaged or the tensile strength is not negatively affected. The elements 200, 202 have a tensile strength such that 205

will tear before 200, 202 do, see again col. 9, lines 28-30. Also note col. 9, lines 20-24.

With regard to the last subsection of claim 40, see col. 7, lines 6-12 and col. 6, lines 23-28 and Figures 5-7, i.e. the front one of 200, 202 can be unitary with 205, i.e. front panel/bond torn but rear panel is not.

Claims 1, 8 and 40-43 are not anticipated by Johnson et al. For a reference to anticipate a claim, the reference must disclose each and every element or limitation of the claim. Johnson et al. does not disclose each and every element or limitation of independent Claims 1 and 40-43. Johnson et al. does not disclose: (a) a second ear panel formed of a second material different from the first ear panel material; (b) the second material having a basis weight greater than a basis weight of the first material; and/or (c) at least one manually tearable passive bond connecting the first ear panel and the second ear panel together, as required by Applicants' claimed invention.

As set forth at Col. 5, lines 22-63, Johnson et al. discloses a method for making a flangeless seam useful in disposable articles. As shown in Fig. 9A, a web 400 having longitudinal side edges 410 is processed into a disposable article 15 having first members 200 and second members 202 which are to be joined. Referring to Figs. 9A-9G, first members 200 and second members 202 are made from the same web 400 and, thus, comprise the same material, unlike the first ear panel and the second ear panel of Applicants' claimed invention.

The Examiner alleges that Johnson et al. discloses at Col. 7, line 60 through Col. 8, line 8, that the first member 200 and the second member 202 are different materials. Applicants respectfully disagree with the Examiner's reading of this paragraph. Johnson et al. discloses that a laminate 220 is formed comprising the second member 202, the proximal portion 210 and the distal portion 212 of the first member 200, and the barrier member 205. Further, Johnson et al. discloses that each material, i.e., the first member 200 and the second member 202, included in laminate 220 can each comprise a single layer material or a laminate material. See Johnson et al. at Col. 7, line 60 through Col. 8, line 8. Referring to Figs. 9A-9G, the method disclosed at Col. 5, lines 22-63 requires that the first member 200 and the second member 202 are made of the same web 400 and, thus, the same material or laminate. Therefore, Johnson et al. does not disclose a first ear panel formed of a first material and a second ear panel formed of a second material different from the first material, as required by Applicants' claimed invention.

The Examiner further alleges that Johnson et al. discloses a second material having a basis weight greater than a basis weight of a first material, stating: "At the very least, one of 200 or 202 could be a single layer of material and the other of 200 or 202 can be a layer of that material and another layer, i.e. a laminate or 'different material' which has a basis weight greater than the one member or since the panels are shown as the same thickness and size but they can be of different materials

the members can have different basis weights.” Johnson et al. does not disclose that the first member 200 and the second member 202 can have different basis weights, as required by Applicants’ claimed invention. In fact, beginning at Col. 5, line 23, Johnson et al. discloses a preferred method of making a flangeless seam wherein a web 400 is provided having longitudinal side edges 410 that will be processed into disposable article 15 having first members 200 and second members 202 to be joined, as shown in Fig. 9A. Thus, Johnson et al. discloses first members 200 and second members 202 made of the same web material 400 and, thus, having the same basis weight. Further, as discussed above, Johnson et al. does not disclose “a layer of that material and another layer, i.e. a laminate or ‘different material’ which has a basis weight greater than the one member or since the panels are shown as the same thickness and size but they can be of different materials the members can have different basis weights,” as alleged by the Examiner.

Johnson et al. does not disclose at least one manually tearable passive bond connecting the first ear panel and the second ear panel together, as required by Applicants’ claimed invention. Rather, Johnson et al. teaches using a barrier member 205 positioned between the materials that will tear with less force than is needed to separate the bonds connecting the barrier member to the proximal portion and the distal portion.

Thus, Johnson et al. does not disclose a second ear panel formed of a **second material different from the first material wherein the second material has a basis weight greater than a basis weight of the first material**, as required by Applicants' claimed invention. Although Johnson et al. mentions that the materials included in the laminate 220 may comprise single layer materials or laminates, Johnson et al. does not disclose that the second material is different than the first material and does not disclose that the materials may have different basis weights, with the second material having a basis weight greater than a basis weight of the first material. Further, Johnson et al. does not teach at least one **tearable passive bond** connecting the first ear panel and the second ear panel together, as required by Applicants' claimed invention.

The missing subject matter is not inherent or necessarily disclosed in Johnson et al. Citing MPEP 2112.01, the Examiner alleges that "[w]ith regard to the functions, properties and capabilities of the 'passive bond' as defined in the independent claims, see claim language interpretation section supra, the Johnson device includes all the structure of the claims. Therefore there is sufficient factual basis for one to conclude that the functions, properties and capabilities of the claimed structure are inherent in the same structure of Johnson." Contrary to the Examiner's assertion, the missing descriptive matter is not necessarily present in the article described in Johnson et al.

To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (quoting *Hansgirk v. Kemmer*, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939)) provides: Inherency, however may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. *Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1262, 20 USPQ 1746, 1749-50 (Fed. Cir. 1991).

Thus, the missing element or function must necessarily result from Johnson et al.

Johnson et al. merely discloses a method for making a flangeless seam useful in disposable articles. As discussed above, the Johnson et al. method includes processing a web having longitudinal side edges into a disposable article having joined first members and second members made from the same web and, thus, comprising the same material. Therefore, the missing elements, namely, a second ear panel formed of a second material different from the first ear panel material; a second material having a basis weight greater than a basis weight of the first material; and at least one manually tearable passive bond connecting the first ear panel and the second ear panel together, do not necessarily result from Johnson et al.

As stated by the Federal Circuit:

For a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in the prior art. ... Although this disclosure requirement presupposes the knowledge of one skilled in the art of the claimed invention, that presumed knowledge does not grant a license

to read into the prior art reference teachings that are not there.
Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461, 43 USPQ 2d 1481, 1490 (Fed. Cir. 1997).

Johnson et al. does not disclose each and every element or limitation of independent Claims 1, 40, 41, 42 and/or 43, as required for a reference to anticipate a claim under 35 U.S.C. § 102.

Accordingly, Applicants respectfully urge that Claims 1, 8 and 40-43 are not anticipated by Johnson et al. Applicants respectfully request reversal of the rejection of Claims 1, 8 and 40-43 under 35 U.S.C. § 102(b) as being anticipated by Johnson et al.

Claims 2-7 Are Patentable Over Johnson et al.

In the final Office Action mailed 19 March 2004, the Examiner rejected Claims 2-7 under 35 U.S.C. § 103(a) as being unpatentable over Johnson et al.

Claims 2-7 depend from and further limit independent Claim 1, which Applicants believe is patentable for at least the reasons presented above.

The Examiner alleges that, “[w]hile the criticality of different basis weights of first and second materials of front and rear ears passively bonded to each other directly to form side seams is disclosed, the criticality of specific basis weights and tensile strengths has not been disclosed.” The Examiner contends that “the general conditions of the claims are taught by the prior art, i.e. materials of different basis weights forming panels bonded together.” Therefore, the Examiner alleges that

since the general conditions are disclosed by the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.

As discussed above, Johnson et al. fails to disclose or teach important limitations of Applicants' claimed invention. Johnson et al. does not disclose *a second ear panel formed of a second material different from the first material* extending from a first edge portion of the back waist region, *the second material having a basis weight greater than a basis weight of the first material*, as required by independent Claim 1. Thus, Johnson et al. does not teach or suggest the basis weight limitations of Claims 2-6. Nor does Johnson et al. teach or suggest a peak load tensile strength of about 8.5 lbs. to about 100 lbs., as required by Claim 7.

Accordingly, Applicants respectfully urge that Johnson et al. does not render Applicants' claimed invention obvious in the manner required by 35 U.S.C. § 103(a). Applicants respectfully request reversal of the rejection of Claims 2-7 under 35 U.S.C. § 103(a) as being unpatentable over Johnson et al.

**Claims 9-12 Are Patentable Over Johnson et al. In
View Of McNichols And Thus Also Morman**

In the final Office Action, the Examiner rejected Claims 9-12 under 35 U.S.C. § 103(a) as being unpatentable over Johnson et al. in view of McNichols and thus also Morman.

Claims 9-12 depend from and further limit independent Claim 1, which Applicants believe is patentable for at least the reasons presented above.

As discussed above, Johnson et al. fails to disclose or teach important limitations of Applicants' claimed invention. Johnson et al. does not disclose *a second ear panel formed of a second material different from the first material* extending from a first edge portion of the back waist region, *the second material having a basis weight greater than a basis weight of the first material*, as required by independent Claim 1. Because Johnson et al. does not teach or suggest a first material and a different second material, as required by Applicants' claimed invention, one having ordinary skill in the art would not be motivated to employ the materials and peel strengths as taught by McNichols on the Johnson et al. article, as alleged by the Examiner.

Alternatively, the deficiencies of Johnson et al. are not overcome by McNichols. As discussed above, Johnson et al. does not teach every element or limitation required by Applicants' claimed invention. McNichols teaches a method of providing disposable absorbent articles by first providing a continuously moving web of outer cover material and then intermittently connecting additional components to the continuously moving web of outer cover material. For example, a pair of laterally opposed side panels 28 can be attached to one of the waist regions 22 and 24 of each diaper 20 on the continuously moving web of interconnected diapers 80.

However, McNichols does not teach *a second ear panel formed of a second material different from the first material* extending from a first edge portion

of the back waist region, *the second material having a basis weight greater than a basis weight of the first material*, nor does McNichols teach *at least one manually tearable passive bond connecting the first ear panel and the second ear panel together*, as required by independent Claim 1.

Accordingly, Applicants respectfully urge that Johnson et al. in view of McNichols and thus Morman does not render Applicants' claimed invention obvious in the manner required by 35 U.S.C. § 103(a). Applicants respectfully request reversal of the rejection of Claims 9-12 under 35 U.S.C. § 103(a) as being unpatentable over Johnson et al. in view of McNichols and thus Morman.

VIII. CONCLUSION

For the forgoing reasons, Applicants respectfully request the Board to reverse the rejections of: Claims 1, 8 and 40-43 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent 5,622,589 (“Johnson et al.”); Claims 2-7 under 35 U.S.C. § 103(a) as unpatentable over Johnson et al.; and Claims 9-12 under 35 U.S.C. § 103(a) as unpatentable over Johnson et al. in view of U.S. Patent 6,036,805 (“McNichols”), and thus also U.S. Patent 5,226,992 (“Morman”).

Respectfully submitted,



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APPENDIX A

1. An absorbent article comprising:
 - a front waist region, a back waist region, and a crotch region extending between the waist regions,
 - a first ear panel formed of a first material extending from a first edge portion of the front waist region;
 - a second ear panel formed of a second material different from the first material extending from a first edge portion of the back waist region, the second material having a basis weight greater than a basis weight of the first material; and
 - at least one manually tearable passive bond connecting the first ear panel and the second ear panel together.
2. The absorbent article of Claim 1 wherein the second material has a basis weight of at least about 20 gsm.
3. The absorbent article of Claim 1 wherein the first material has a basis weight of less than about 20 gsm.
4. The absorbent article of Claim 1 wherein the second material has a basis weight of at least about 30 gsm.

5. The absorbent article of Claim 1 wherein the first material and the second material each has a basis weight of at least about 20 gsm.
6. The absorbent article of Claim 1 wherein the first material and the second material each has a basis weight of about 30 gsm to about 60 gsm.
7. The absorbent article of Claim 1 wherein the second material has a peak load grab tensile strength of about 8.5 lbs. to about 100 lbs.
8. The absorbent article of Claim 1 wherein the first ear panel is passively bonded to the second ear panel by one of sonic welding, adhesive bonding, thermal bonding and combinations thereof.
9. The absorbent article of claim 1 wherein the first material comprises a point bonded nonwoven material.
10. The absorbent article of claim 1 wherein the second material comprises a laminate having at least one film layer positioned between two layers of polypropylene spunbond material.

11. The absorbent article of claim 1 wherein each passive bond has a peel strength of less than about 5000 grams.

12. The absorbent article of claim 1 wherein each passive bond has a peel strength of about 1500 grams to about 3000 grams.

40. An absorbent article comprising:
a front waist region, a back waist region, and a crotch region extending between the waist regions,
a first ear panel formed of a first material extending from a first edge portion of the front waist region;
a second ear panel formed of a second material different from the first material extending from a first edge portion of the back waist region; and
at least one manually tearable passive bond connecting the first ear panel and the second ear panel together,
wherein in disconnecting the first ear panel from the second ear panel, the first ear panel is damaged more than the second ear panel.

41. An absorbent article comprising:

a front waist region, a back waist region, and a crotch region extending between the waist regions,

a first ear panel formed of a first material extending from a first edge portion of the front waist region;

a second ear panel formed of a second material different from the first material extending from a first edge portion of the back waist region; and

at least one manually tearable passive bond connecting the first ear panel and the second ear panel together,

wherein the passive bond can be torn without damaging the second ear panel more than the first ear panel.

42. An absorbent article comprising:

a front waist region, a back waist region, and a crotch region extending between the waist regions,

a first ear panel formed of a first material extending from a first edge portion of the front waist region;

a second ear panel formed of a second material different from the first material extending from a first edge portion of the back waist region; and

at least one manually tearable passive bond connecting the first ear panel and the second ear panel together,

wherein the first ear panel can be disconnected from the second ear panel without negatively affecting a tensile strength of the second ear panel.

43. An absorbent article comprising:

a front waist region, a back waist region, and a crotch region extending between the waist regions,

a first ear panel formed of a first material extending from a first edge portion of the front waist region;

a second ear panel formed of a second material different from the first material extending from a first edge portion of the back waist region; and

at least one manually tearable passive bond connecting the first ear panel and the second ear panel together,

wherein the first ear panel can be disconnected from the second ear panel without negatively affecting a tensile strength of the first ear panel.